

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : T. KLOS et al.

Group Art Unit: 2616

Appl No.: 09/853,722

Examiner: Toan Nguyen

Filed : May 14, 2001

Confirmation No.: 6623

For: METHOD AND SYSTEM FOR PROVISIONING DIGITAL SUBSCRIBER
LINE FACILITIES

REPLY BRIEF UNDER 37 C.F.R. §41.41

Commissioner for Patents
U.S. Patent and Trademark Office
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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to an Examiner's Answer dated April 23, 2008, which begins the two-month period for filing of the Reply Brief to expire on June 23, 2008, Appellants respectfully submit this Reply Brief Under 37 C.F.R. §41.41. Claims 1-38, all of the claims pending in this application, stand finally rejected and are the subject of this appeal. Appellants maintain that each and every reason set forth in the Appeal Brief filed January 13, 2008 for patentability of the pending claims is correct, and again request that the decision to reject claims 1-38 under 35 U.S.C. § 103(a) be reversed and that the application be returned to the Examining Group for allowance.

1. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS UNDER 35 U.S.C. § 103(a) FOR CLAIMS 1-38

According to MPEP § 2142, the key to establishing and supporting a *prima facie* case of obviousness under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Contrary to the guidance provided by the Federal Circuit and the MPEP, the Examiner on pages 4-22 of the Examiner's Answer is justifying the obviousness rejections with inadequate circular reasoning and mere conclusory statements.

For example, the Examiner's Answer asserts on pages 5-6 that claim 1 is unpatentable over SUNDARESAN et al. in view of GIDWANI, because:

One skilled in the art would have recognized the determining an interface corresponding to each of the plurality of assigned facilities, each interface converting at least a portion of the provisioning data into a specific protocol

corresponding to the assigned facility, *and would have applied Gidwani's UIP server in Sundaresan et al.'s service order. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Gidwani's apparatus and method for intelligent scalable switching network in Sundaresan et al.'s processing orders for high bandwidth connections with the motivation being to provide the scalable intelligent multimedia network.* [emphasis added]. (See, pages 5-6 of the Examiner's Answer.)

The Examiner's flawed and circular reasoning is that one skilled in the art would have recognized certain features in SUNDARESAN et al. and GIDWANI as being prior art, and therefore, it would have been obvious to one of ordinary skill to use these features for intelligent scalable switching network "with the motivation being to provide the scalable intelligent multimedia network". The Examiner's logic and reasoning make no sense in the context of the presently claimed invention, especially in view of the fact that Appellants are not claiming a "scalable intelligent multimedia network".

Another example of the Examiner's flawed analysis and circular reasoning appears on pages 8-9, where the Examiner's Answer asserts that claim 18 is unpatentable over SUNDARESAN et al. in view of GIDWANI, because:

One skilled in the art would have recognized the plurality of interface identifiers for interfaces corresponding to the plurality of network facilities, and would have applied Gidwani's UIP server in Sundaresan et al.'s service order. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Gidwani's apparatus and method for intelligent scalable switching network in Sundaresan et al.'s processing orders for high bandwidth connections with the motivation being to provide the scalable intelligent multimedia network. [emphasis added]. (See, pages 8-9 of the Examiner's Answer.)

The Examiner uses the same flawed and circular reasoning for claim 18 by asserting that one skilled in the art would have recognized certain features in SUNDARESAN et al. and GIDWANI as being prior art, and therefore it would have been obvious to one of ordinary skill to use these features for intelligent scalable switching network “with the motivation being to provide the scalable intelligent multimedia network”. The reasoning for claim 18 appears to be a cut and paste version (the identical text is italicized) of the reasoning for claim 1, except for a different laundry list of features copied from claim 18. Like the reasoning provided for claim 1, the Examiner’s logic and reasoning for claim 18 make no sense in the context of the presently claimed invention.

Still another example of the Examiner’s flawed analysis and circular reasoning appears on pages 10-11 of the Examiner’s Answer, where there is an assertion that claims 8-17, 20-21 and 24-38 are unpatentable over SUNDARESAN et al. in view of GIDWANI, and further in view of BYERS, because:

One skilled in the art would have recognized the determining an interface for each of the plurality of facilities, each interface enabling communication with the corresponding one of the plurality of facilities, ***and would have applied Gidwani’s UIP server in Sundaresan et al.’s service order. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use Gidwani’s apparatus and method for intelligent scalable switching network in Sundaresan et al.’s processing orders for high bandwidth connections with the motivation being to provide the scalable intelligent multimedia network.*** [emphasis added]. (See, pages 10-11 of the Examiner’s Answer.)

Again, the Examiner's flawed and circular reasoning is that one skilled in the art would have recognized certain features in SUNDARESAN et al. and GIDWANI as being prior art, and therefore, it would have been obvious to one of ordinary skill to use these features for intelligent scalable switching network "with the motivation being to provide the scalable intelligent multimedia network". The reasoning for claims 8-17, 20-21 and 24-38 is another cut and paste version (the identical text is italicized) of the reasoning for claims 1 and 18, except for a different laundry list of features copied from claim 8.

Some additional and slightly different cut and paste reasoning appears on page 12 of the Examiner's Answer, where it is asserted that claims 8-17, 20-21 and 24-38 are unpatentable over SUNDARESAN et al. in view of GIDWANI, and further in view of BYERS, because:

One skilled in the art would have recognized the optical concentrator device connectable to the remote terminal to use the teachings of Byers in the system of Sundaresan et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the optical concentrator device connectable to the remote terminal as taught by Byers in Sundaresan et al. with the motivation being to provide less expensive loops than copper loops by converting switch interfaces to fiber and back to copper at the remote terminal and consist of any optical terminal that interfaces with the optical links from the switching system. [emphasis added]. (See Examiner's Answer, page 12.)

The Examiner's reasoning is that one skilled in the art would have recognized an optical concentrator as a prior art feature, and therefore it would have been obvious to one of ordinary skill to use less expensive optical loops instead of copper loops. Like the flawed and circular reasoning provided for the other claims described above, the Examiner's logic and reasoning on page 12 make no sense, especially in view of the fact that the claims are not directed to replacing

copper loops with optical loops. The same and virtually identical reasoning appears on pages 16, 19, 22 of the Examiner's Answer.

Other variations of this flawed and circular reasoning appear on pages 15 and 18 of the Examiner's Answer, where it is asserted, "with the motivation being to provide the scalable intelligent multimedia network". As pointed out above, Appellants' claims do not recite a "scalable intelligent multimedia network".

Appellants respectfully submit that the asserted flawed and circular reasoning provided by the Examiner includes mere conclusory statements that are not supported by articulated reasoning. Reciting a laundry list of features (copied from the claims) which are allegedly known in the art and reciting desirable objectives such as "scalable intelligent multimedia networks" and "less expensive loops", which are not even rationally related to the claim recitations, are insufficient as a matter of law to support a finding of unpatentability. The finding of unpatentability needs to be justified by more than the flawed, circular reasoning and irrelevant desirable objectives found in the quoted statements above, in order to meet the standard of "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" set forth in MPEP § 2142, in the *KSR* decision, and by Federal Circuit.

Accordingly, because the Examiner has failed to establish and support a *prima facie* case of obviousness supported by articulated reasoning with some rational underpinning on pages 4-

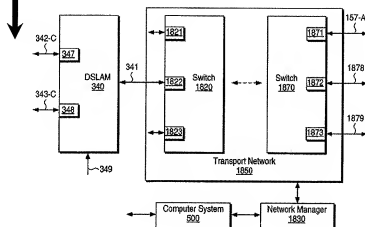
22, the Board is respectfully requested to overturn the Examiner's rejection of claims 1-38 as being unpatentable over the cited prior art.

2. THERE IS NO DISCLOSURE OF THE CLAIMED PROVISIONING

The Examiner's Answer on pages 23 to 25 makes reference to portions of SUNDARESAN et al. which the Examiner is relying upon to rebut Appellants' arguments that SUNDARESAN et al. and GIDWANI do not render obvious the claimed actual provisioning of DSL services having a remote terminal and interface of the type disclosed and claimed by Appellants. The Examiner asserts on page 24, "Therefore, SUNDARESAN et al. clearly teach the actual provisioning of DSL services, and applicable to the actual provisioning". The actual provisioning asserted by the Examiner, however, does not configure a remote terminal having an interface connected to a DSL subscriber, as being claimed by Appellants in claims 1-38. In order to illustrate the difference between what Appellants are claiming and what the Examiner is asserting as actual provisioning, an annotated copy of Fig. 18 of SUNDARESAN et al. is provided below:

There is no disclosure in SUNDARESAN et al. of provisioning and configuring a remote terminal having an interface, as claimed by Appellants. There is no disclosure of any provisioning beyond DSLAM 340 of SUNDARESAN et al.

FIG. 18



The Appellants' claimed invention of claims 1-38 is directed to a method, system or computer readable medium for provisioning a digital subscriber line (DSL) service for a subscriber including at least a remote terminal having an interface connectable to a terminal of the DSL subscriber. However, in SUNDARESAN et al. there is no disclosure of any actual provisioning that includes the configuration of a remote terminal having an interface of the type claimed by Appellants. SUNDARESAN et al. suggests at col. 29, lines 47-53 that the computer

system 500 may “coordinate” the configuration of CPE (customer provided equipment) at the user location. SUNDARESAN et al. do not disclose any provisioning or configuring at the user location which is beyond the DSLAM 340 in Fig. 18 of SUNDARESAN et al., and there is certainly no disclosure of a remote terminal having an interface.

The automatic provisioning asserted on page 24 the Examiner’s Answer relates to the DSLAM 340 and the Transport Network 1850 and not the provisioning of a remote terminal having an interface, as claimed by Appellants. The appealed claims are directed to provisioning DSL services (claims 1-17), a system for provisioning DSL services (claims 18-30) or a computer readable medium for provisioning DSL services (claims 31-37), *e.g.*, by determining assigned facilities (including a remote terminal) having interfaces (see, for example, RT 102, RT controller 104, OCD 104, EMS 116, FIG. 1 and page 24, line 18 to page 25, line 12), converting service orders into provisionable steps and/or actually configuring the facilities (including a remote terminal) having interfaces to implement the requested service. The automatic provisioning asserted on page 24 the Examiner’s Answer is not the same as the provisioning claimed by Appellants in claims 1-38.

3. THE EXAMINER FAILS TO EXPLAIN THE REJECTION OF THE DEPENDENT CLAIMS

The Examiner’s Answer on pages 26 to 29 reiterates the portions of the cited references that the Examiner asserts corresponds to the features of the Appellants’ dependent claims without

any explanation of how these features can be combined with the features of the independent claims. For example, the Examiner takes issue with Appellants' assertion that the Examiner has failed to show the claimed "at least one path interconnecting the plurality of facilities and a subscriber port of the remote terminal, the subscriber port being configured to connect with the DSL subscriber terminal". The Examiner alleges that SUNDARESAN et al. discloses this feature on page 26 of the Examiner's Answer. However, the Examiner has not shown that SUNDARESAN et al. includes the claimed remote terminal having a subscriber port and an interface, and there is no teaching, showing or suggestion anywhere in SUNDARESAN et al. of configuring of the undisclosed subscriber port, as recited in claim 2.

Since the Examiner has failed to explicitly show that the cited prior art teaches the claimed features of claim 2 or any of the other dependent claims, and since the Examiner has failed to provide a rational for why these missing features can be combined with the features of their respective independent claims, Appellants respectfully submit that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to the dependent claims. Accordingly, the Board is respectfully requested to reverse the Examiner's decision to reject the dependent claims.

4. CONCLUSION

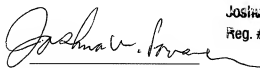
In view of the herein contained arguments, Appellants respectfully request that the decision of the Examiner to reject claims 1-38 set forth in the Official Action of June 15, 2007,

be reversed together with an indication of the allowability of all pending claims. Such action is respectfully requested and is believed to be appropriate and proper.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

If there are any questions concerning this Reply Brief or the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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June 20, 2008
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